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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/717,901	11/21/2003	Askar Karami	213202.00488	7360

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PATENT ADMINISTRATOR
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EXAMINER

COONEY, JOHN M

ART UNIT PAPER NUMBER

1711

DATE MAILED: 08/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/717,901

Applicant(s)

KARAMI ET AL.

Examiner

John m. Cooney

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,7-10,20-22,25-29,31-40,44-47,57-59,62-66,68-72 and 75-77 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,7-10,20-22,25-29,31-40,44-47,57-59,62-66,68-72 and 75-77 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Applicant's arguments filed 6-9-06 have been fully considered but they are not persuasive.

All previous rejections are withdrawn in light of applicants' amendments.

The following is set forth as new:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 7-10, 20-22, 25-29, 31-40, 44-47, 57-59, 62-66, 68-72, 75-77 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wiese et al.(WO 00/73368).

Wiese et al. discloses preparations of polyurethane foams prepared from isocyanates reading on toluene diisocyanates (TDI) and diphenylmethane diisocyanates (MDI) as claimed, polyether polyols having molecular weights as claimed, water as a blowing agent, and phenolic resins as crosslinkers in amounts and having functionalities as claimed, wherein the preparations were prepared through formation of polyol resin premixes containing the phenolic resins as claimed and are used to prepared slabstock and molded foams as claimed (see abstract, page 5, paragraph bridging pages 6 and 7, page 8 bottom, page 9, 10, and 11, paragraph bridging pages

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13 and 14, page 16 lines 21-23, page 19 last paragraph, page 21 line 16- page 22 line 20, and the examples, as well as, the entire document).

Wiese et al. differs from applicants' claims in that the melting temperatures of their phenolic resins do not specifically overlap. For example, the exemplified phenolic resins, GPRI CK-2500, of Wiese et al.'s disclosure has a softening point (point at which substances without a sharp melting point change from viscous to plastic flow) of 104 to 116 degrees Celsius. However, Wiese et al. teaches that a large number of phenolic resins were tested for the purposes of imparting their phenolic resin component's crosslinking effect. Accordingly, it would have been obvious for one having ordinary skill in the art to have operated within the large selection of phenolic resins disclosed by Wiese in the making of the preparations of Wiese et al. for the purpose of imparting their crosslinking effect in order to arrive at the products and processes of applicants' claims with the expectation of success in the absence of a showing of new or unexpected results. Additionally, it has long been held that where the general conditions of the claims are disclosed in the prior art, discovering the optimal or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233; *In re Reese* 129 USPQ 402 . Further, a prima facie case of obviousness has been held to exist where the proportions of a reference are close enough to those of the claims to lead to an expectation of similar properties. *Titanium Metals v Banner* 227 USPQ 773. (see also MPEP 2144.05 I) Similarly, it has been held that discovering the optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272,205 USPQ 215 (CCPA 1980).

The following teachings not relied upon are retained as being art of interest:

The Georgia Pacific Technical Data sheet (Novolak Resins) is cited for its disclosure of information pertaining to GPRI CK-2500, Yuge et al., Munzenberger et al., and Ishikawa et al. are cited for their disclosures of the use of phenolic resins' as reactants, carbon supplying compounds, and fillers in urethane foam synthesis operations. Hutchings et al. is cited for its disclosure and manipulation of various phenolic resins in the art, including GPRI CK-2500. Wiese et al. (see abstract, column 4 lines 38-61, column 5 lines 53-64, column 7 line 22 – column 9 line 20, column 9 lines 51-60, column 11 lines 43-50, column 13 lines 37-46, column 16 lines 5-12, column 17 line 37 – column 18 line 28, and the examples, as well as, the entire document) is cited for its equivalent disclosure to WO 00/73368.

Applicant's arguments with respect to claims 1-3, 7-10, 20-22, 25-29, 31-40, 44-47, 57-59, 62-66, 68-72, 75-77 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any


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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Cooney whose telephone number is 571-272-1070. The examiner can normally be reached on M-F from 9 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck, can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


JOHN M. COONEY,
PRIMARY EXAMINER
Group 1700